

REMARKS

This communication is responsive to the Office Action mailed September 25, 2006.

Claim Amendments

Independent claim 1 is amended to include a feature that is a generic version of the feature recited in dependent claims 13 and 14. More particularly, claim 1 is amended to include the feature of:

wherein a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance reads on the at least one patent claim

Dependent claims 13 and 14 are amended to be in independent form, with no change in scope thereof.

Claims 22-25 are amended in form only, to correct the typographical error of “architecture” to system.

Claim 4 is amended to delete the errant extra “by concept node” recitation.

Claim Objections

Claim 4 has been amended to correct the typographical error pointed out by the Examiner.

Double Patenting

The double patenting rejection, while provisional only, no longer applies in any event given the amendment to claim 1, which now incorporates a feature that is a generic version of the feature recited in dependent claims 13 and 14. It is noted that claims 13 and 14 were not implicated in the double patenting rejection.

In addition, Applicant respectfully submits that the Examiner is in error in making the assertion of an “obvious variation” that “patent claims are simply text documents.” Applicant does not waive the right, by amending the claims, to challenge this assertion in the future, should it become necessary.

Rejection under 35 USC § 101

The Examiner has rejected claims 1-12 as being directed to non-statutory subject matter. Claim 1 is an independent claim, and claims 2-12 depend on claim 1.

The rejection under 35 USC § 101 no longer applies given the amendment to claim 1, which now incorporates a feature that is a generic version of the feature recited in dependent claims 13 and 14.

With respect to claims 3 and 4, these claims are not directed to a “computer program.” Rather, they recite that particular steps of a claim on which claims 3 and/or 4 depend are carried out by a computer. This is not the same as reciting a computer program in the abstract.

Rejection under 35 USC § 102

Claims 1, 11-12 and 18-25 are rejected under 35 USC § 102(b) as being anticipated by the published patent application to Roux. While claim 1 has been amended to incorporate a feature that is a generic version of the feature recited in dependent claims 13 and 14, it is respectfully submitted that even the original claim 1 is not anticipated by Roux. Furthermore, rejected independent claim 21 has not been amended.

As recited in MPEP 2131,

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Taking claim 1 as an example only, this claim includes (even before amendment) a feature of “a) determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology.” This feature is not “either expressly or inherently described” in Roux. The Examiner’s statement that “a patent claim is simply text” (with which Applicant vehemently disagrees) does not remove the requirement that a reference, to be anticipatory, must “either expressly or inherently describe” every feature.”

The Examiner appears to agree that Roux does not expressly describe every feature recited in the rejected claims. While the Examiner has not asserted that Roux inherently describes dealing with a patent claim in the manner recited in the rejected claims, Applicant notes for now that MPEP 2112, IV (EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY), specifies the following with respect to inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In *re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

In summary, since Roux does not describe each and every feature set forth in claims 1, 11-12 and 18-25, the anticipation rejection is improper and must be withdrawn.

Rejections under 35 USC § 103

A. Roux and Stobbs – Claims 2-5 and 13-14

Claims 2-5 and 13-14 are rejected under 35 USC § 103 as being obvious over Roux in view of Stobbs.

As mentioned several times above, claim 1 (on which claims 2-5 depend) has been amended to incorporate a feature that is a generic version of the feature recited in dependent claims 13 and 14. Furthermore, claim 2 has been amended to recite that the “claim record” is completed “indicating the correspondence determined in step a)” and the “instance record” is completed “indicating the correspondence determined in step b).” Claims 13 and 14, though amended, are amended in form only and are of precisely the same scope as before amendment.

Turning now to the rejection, in the first place, the Examiner notes with particular respect to the rejection of claim 2 that paragraph [0049] of Stobbs discloses “The claims Table clearly contains claim records.” The “claims Table 60” does not, however, indicate a determined correspondence of portions of at least one patent claim to concept nodes of an ontology (which is a rough statement of “indicating the correspondence determined in step a).” Rather, as recited at paragraph [0049] of Stobbs,

The claims Table 62 stores the claim text, and indicia as to whether the claim is independent or dependent, and an adjusted claim word count that is used as a claim breadth metric.

The Examiner further states “Applicant’s Specification clearly shows that claim records and instance records can be interchangeable.” Applicant notes that “similarity” does not necessitate “interchangeability.” That is, while paragraph [0083] of Applicant’s specification indicates that claim records and instance records themselves, in one example, are “similar,” this does not mean that a feature of “completing a claim record” as recited in claim 2 can be considered as interchangeable with “completing an instance record” as recited in claim 2.

Furthermore, as discussed above with respect with respect to the anticipation rejection of claim 1, the Examiner’s premise that “Roux discloses all the elements of claim 1” is also faulty, even as applied to original claim 1.

Thus, for at least the reasons that Roux does not disclose all the elements of claim 1 (even original claim 1, prior to amendment) and that Stobbs does not disclose “completing a claim record . . .” as recited in claim 2, the obviousness rejection of claim 2 is improper and should be withdrawn.

With respect to claims 3-5, the subject matter of these claims is patentable for at least the reasons set forth with respect to claims 1 and 2.

With respect to claim 13, the subject matter of this claim is patentable for at least the reasons set forth with respect to claim 1 (and claims 2 and 5). Furthermore, claim 13 recites “a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance infringes the at least one patent claim.”

The portion of Stobbs cited by the Examiner (paragraphs [0108] and [0109]) relative to claim 13 merely discloses, at best, that module 188 is used to identify “likely candidates for possible infringement of the claims at issue” by using Internet search engine 186 to generate two sets of search results and identify “web pages that are in both sets of search results.” The search results are (1) results of presenting the claims as a query and (2) results of presenting product descriptions of the products covered by those claims. The “products” whose descriptions are used to determine the second search results are not potentially infringing products. The “products” are “a client’s product that is covered by the claims at issue.”

The “Internet search engine 186” is disclosed as being, for example, the Alta Vista search engine and is not disclosed as using an ontology. Furthermore, no determination of infringement is ever made; only “likely candidates” are determined. Stobbs [0109] discloses

Module 190 uses Internet search engine 186 to automatically search the Internet for content that matches or are significantly similar to the linguistic results of the patent claims at issue from the aforementioned linguistic engines. Preferably, patent priority data, such as patent filing date or foreign filing priority date, are used to focus the Internet searching. Examples of Internet search engines include, but are not limited to, the Internet search engine provided by AltaVista.

In both the case of the Product Coverage / Invalidity Analysis module 188 and of the Validity Analysis module 190, there is no “processing the determined correspondence [to an ontology] of the at least one patent claim and the determined correspondence [to the ontology] of the at least one instance.” No ontology is involved whatsoever.

The Examiner contends “The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs ... such that it is possible to discover documents, products or product descriptions that validate, invalidate, or infringe upon a patent claim.” In the first place, as discussed above, Stobbs only discloses finding possibly infringing and possibly invalidating materials. Furthermore, at best, Stobbs suggests the desirability of finding potentially infringing or invalidating references. There is nothing in Stobbs that suggests somehow modifying Roux to find actually infringing or actually invalidating references. To the

extent it may be well known that it is desirable to find actually infringing or actually invalidating references, there is nothing to suggest modifying Roux to operate on patent claims at all, let alone to find actually infringing or actually invalidating references.

To the extent claim 14 is similar to claim 13, Applicant advances similar arguments over the combination of Roux and Stobbs. Furthermore, Stobbs appears to disclose only processing issued claims and not claims of applications.

B. Roux, Stobbs and Copperman – Claims 6-10

Claims 6-10, dependent on claim 5, are allowable for at least the reasons that claim 5 is allowable.

Furthermore, the Examiner states that

However, Copperman discloses where determining a comparison includes determining whether there is a one to one correspondence between concept nodes in claim records and concept nodes in instance records (Copperman: column 15, lines 8-11).

What Copperman actually states at column 15, lines 8-11, is:

In one embodiment, classifications used by the text classifiers correspond one-to-one with concept-nodes within topic taxonomies. A separate text classifier is applied for each taxonomy.

In the first place, “claim records” are mentioned nowhere in Copperman, contrary to the Examiner’s allegation. Furthermore, classifications corresponding one-to-one to concept nodes has nothing to do with determining a correspondence of concept nodes to concept nodes.

C. Roux, Stobbs and Sheremetyeva – Claims 15-17

Claims 15-17, dependent on claim 14, are allowable for at least the reasons that claim 14 is allowable.

In the first place, the Examiner notes “It is important to note that a description of an embodiment of an invention is simply text.” Like the Examiner’s statement that “a claim is simply text,” this statement regarding an “embodiment of an invention” being simply text is unsupported and improper.

Furthermore, with respect to Shremetyeva, the Examiner contends that:

Shremetyeva discloses processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon (Shremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

Applicant’s claim 15 recites

determining a correspondence of the portions of an embodiment to the concept nodes of the ontology; and processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon.

At best, Shremetyeva elicits from an inventor a correspondence of claim elements to a conceptual schema. For example, see page 3, “the system guides the user through the paces of

describing every essential feature of the invention.” Shremetyeva’s formulated claim is the goal, and the formulated claim is based on the claim elements provided by the inventor. On the contrary, according to claim 15, the formulated at least one patent claim is one that can then be tested against the prior art (see text of claim 14).

Furthermore, as recited in claim 16, for example, a result of testing the formulated at least one patent claim can be used as input to formulating other patent claims. The Examiner contends that “If one can generate a first patent claim, one can generate a second patent claim.” While this may be true, there is more to claim 16 than this, and the Examiner is not free to ignore recitations in claim 16. In fact, as the Examiner concedes, Shremetyeva does not even disclose analyzing the patent claim to determine whether it is unpatentable. Given that, it is illogical to content that Shremetyeva discloses formulating “a second patent claim” based on such a determination.

CONCLUSION

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

/ASH/
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